

### **REMARKS**

Reconsideration and withdrawal of the rejections to the claims set forth in the Office Action of January 26, 2006 are respectfully requested in view of the following remarks.

#### **Status of the claims**

Claims 1-4 and 6-43 are pending. Claim 5 was previously canceled.

No claims are presently amended.

Claims 1-4 and 6-43 stand rejected under 35 U.S.C. § 103.

#### **The Rejections Under 35 U.S.C. § 103**

The Examiner has rejected claims 1-5, 7-11, 13-21 and 33-36 under U.S.C. § 103(a) as being obvious over Sprague *et al.*, U.S. Patent No. 6,449,720 (the “720 patent”) in view of Shear *et al.*, U.S. Patent No. 6,157,721 (the “721 patent”).<sup>1</sup>

The Examiner has further rejected claim 6, 12, 22-32 and 37-43 under U.S.C. § 103(a) as being obvious over the ‘720 patent in view of the ‘721 patent further in view of Moore *et al.*, U.S. Patent No. 6,696,975 (the “975 patent”).

The Examiner pointed out that applied reference (the ‘720 patent) has a common assignee with the instant application. Based on the earlier effective U.S. filing date of the reference, the applied reference constitutes prior art only under 35 U.S.C. § 102(e). The Examiner states that the rejections under 35 U.S.C. § 103(a) might be overcome by, *inter alia*, showing that the reference is disqualified under 35 U.S.C. § 103(c) as prior art in a § 103(a) rejection.

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<sup>1</sup> Applicants note that claim 5 has been previously canceled, and its cancellation was acknowledged by the Examiner in the instant Office Action. Accordingly, applicants believe that the rejection of claim 5 is in error.

**Statement of Common Ownership**

In response, Applicants, through their agent of record, hereby state that the instant application and U.S. Patent No. 6,449,720 were, at the time the invention of the instant application was made, owned by Wave Systems Corporation.

In support of the statement of common ownership, applicants provide, at **Exhibit 1**, a copy of an Assignment and Notice of Recordation of Assignment. The Assignment was recorded on May 15, 2001 at Reel 001811, Frame 0570 and assigned the invention to Wave Systems Corporation.

Applicants further provide, at **Exhibit 2**, documentation from the United States Patent and Trademark Office web site of the recordation of the Assignment of Application Serial No. 09/313,295 (now U.S. Patent No. 6,449,720). The Assignment was recorded on September 21, 1999 at Reel 010258, Frame 0189 and assigned the invention to Wave Systems Corporation.


By virtue of the above-identified assignments assigning the inventions to Wave Systems Corporation, Applicants have established common ownership of the conflicting '720 patent and the instant application. As such, the '720 patent can not be cited as prior art under 35 U.S.C. § 102(e) as part of an obviousness rejection under § 103(a). Accordingly, applicants respectfully request that the rejection of claims 1-4, 7-11, 13-21 and 33-36 under U.S.C. § 103(a) as being obvious over the '720 patent in view of the '721 patent, and the rejection of claims 6, 12, 22-32 and 37-43 under 35 U.S.C. § 103(a) as being obvious over the '720 patent in view of the '721 patent further in view of the '975 patent, be withdrawn.

**Conclusion**

Applicants earnestly request that the Examiner consider the above remarks and allow the claims to issue.

Applicants believe that no additional fee is due in connection with the filing of this Response. However, Applicants authorize, in the Fee Transmittal Form (submitted herewith in duplicate) the Director to charge payment of any additional fees or credit any overpayment associated with this Response to Deposit Account No. 02-4377.

Respectfully submitted,



Kimberley A. Gavin  
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*Agent for Applicants*

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Gary M. Butter  
Reg. No. 35,225  
*Attorney for Applicants*

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**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

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AUGUST 04, 2001

PTAS



\*101725876A\*

BAKER BOTTS L.L.P.  
GARY BUTTER  
30 ROCKEFELLER PLAZA - 44 FL.  
NEW YORK, NY 10112

**UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT**

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 05/15/2001

REEL/FRAME: 011811/0570  
NUMBER OF PAGES: 4

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS) **BAKER BOTTS L.L.P.**

ASSIGNOR:  
VEIL, LEONARD SCOTT

DOC DATE: 05/11/2001 **01 AUG -9 1PM 12:33**

ASSIGNOR:  
TUPS, ERICA ELISABETH

DOC DATE: 05/11/2001 **TO**

ASSIGNEE:  
WAVE SYSTEMS CORPORATION  
480 PLEASANT STREET  
LEE, MASSACHUSETTS 01238

<b>LAB</b>		
<b>PDA</b>		
<b>DAK</b>		

SERIAL NUMBER: 09855898  
PATENT NUMBER:

FILING DATE: 05/15/2001  
ISSUE DATE:

SHARON LATIMER, EXAMINER  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

05-22-2001



FILE NO. A33941 067668.0137

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U.S. DEPARTMENT OF COMMERCE  
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1. Name of conveying party(ies):  
**Leonard Scott Veil and Erica Elisabeth Tups**  
Additional name(s) of conveying party(ies) attached?  
☐ Yes ☒ No

2. Name and address of receiving party(ies)  
Name: Wave Systems Corporation

3. Nature of conveyance:  
☒ Assignment ☐ Merger  
☐ Security Agreement ☐ Change of Name  
☐ Other

Address: 480 Pleasant Street

City: Lee State: MA Zip: 01238  
Additional name(s) and address(es) attached? Country: U.S.  
☐ Yes ☒ No

Execution Date: May 11, 2001

4. Application number(s) or patent number(s) **09 855 898**

If this document is being filed together with a new application, the execution date of the application is May 11, 2001

A. Patent Application No.(s)

B. Patent No.(s)

Additional numbers attached?

☐ Yes☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name:

BAKER BOTTS L.L.P.  
30 Rockefeller Plaza - 44 Fl.  
New York, NY 10112

6. Total number of applications and patents involved:

7. Total fee (37 CFR 3.41): \$ 40.00

☒ Enclosed  
☐ Authorized to be charged to deposit account

8. Deposit account number:  
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*To the best of my knowledge and belief, the foregoing instrumentation is true and correct and any attached copy is a true copy of the original document.*

Gary Butter

Name of Person Signing

Signature

May 15, 2001

Date

Page 1 of 2

Total number of pages including cover sheet, attachments and document: 4

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J1046 U.S. PTO  
09/855898  
05/15/01

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**ASSIGNMENT**

WHEREAS, WE, LEONARD SCOTT VEIL, a citizen of the United States of America; and ERICA ELISABETH TUPS, a citizen of the United States of America; residing in California, whose post office addresses are 93 Amato Avenue, Campbell CA 95008 and 1672 Fremont Street, Apartment #4, Santa Clara, CA 95050, respectively, have made jointly an invention entitled **"METHOD AND SYSTEM FOR CONDITIONAL INSTALLATION AND EXECUTION OF SERVICES IN A SECURE COMPUTING ENVIRONMENT.@**

WHEREAS, WAVE SYSTEMS CORPORATION (hereinafter "WAVE SYSTEMS"), having its principal place of business at 480 Pleasant Street, Lee, MA 01238, is desirous of acquiring the entire right, title and interest of the said LEONARD SCOTT VEIL and ERICA ELIZABETH TUPSIN and to said invention, and any and all improvements thereon, and in and to any and all United States and foreign patent rights to said invention and improvements;

NOW, THEREFORE, TO ALL WHOM IT MAY CONCERN, BE IT KNOWN, that WE, the said LEONARD SCOTT VEIL and ERICA ELIZABETH TUPS, for and in consideration of the sum of One Dollar (\$1.00), lawful money of the United States, to us in hand paid by said WAVE SYSTEMS, and other valuable considerations unto us moving from said WAVE SYSTEMS, at or before the ensealing and delivery of these presents, the receipt of which is hereby acknowledged, have sold, assigned, transferred and conveyed and by these presents do sell, assign, transfer and convey, unto said WAVE SYSTEMS, its successors and assigns, their entire right, title and interest in and to the said invention entitled **"METHOD AND SYSTEM FOR CONDITIONAL INSTALLATION AND EXECUTION OF SERVICES IN A SECURE COMPUTING ENVIRONMENT@**, as set forth and described in application for Letters Patent of the United States, and any and all improvements thereon, and in and to said application and any division, continuation, continuation-in-part, extensions and substitutions thereof, and in and to any Letters Patent of the United States which may be issued on any of said applications, and any reissues and reexaminations thereof, and in and to any and all applications for Letters Patent filed in foreign countries for said invention and improvements, and any and all Letters Patent which may be granted in foreign countries therefor, **TO HAVE AND TO HOLD THE SAME** to the full end of the term or terms for which any and all said Letters Patent may be granted;

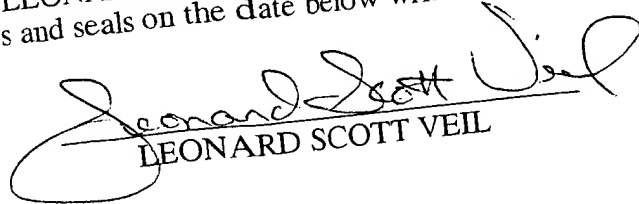
AND WE, the said LEONARD SCOTT VEIL and ERICA ELISABETH TUPS, do hereby authorize and request the Commissioner of Patents and Trademarks to issue the said Letters Patent of the United States to said WAVE SYSTEMS, as the assignee of their entire right, title and interest in and to the same, for the sole use and benefit of said WAVE SYSTEMS, its successors and assigns;

AND WE, the said LEONARD SCOTT VEIL and ERICA ELISABETH TUPS, for the considerations aforesaid, do hereby covenant and agree to and with said WAVE SYSTEMS, its successors and assigns, that WE have the full power to make this assignment, and that the rights assigned are not encumbered by any grant, license or right heretofore given, and that WE, our executors or administrators, shall and will do all lawful acts and things and make, execute and deliver without further compensation, any and all other instruments in writing, further applications, papers, affidavits, powers of attorney, assignments, and other documents which, in the opinion of counsel for said WAVE SYSTEMS, its successors and assigns, may be required or necessary more effectively to secure to and vest in said WAVE SYSTEMS, its successors and assigns, the entire right, title and interest of the said LEONARD SCOTT VEIL and ERICA ELISABETH TUPS in and to said invention and improvements, applications, Letters Patent,

*See Above*  
 RECORDED May 15, 2001  
 11811 INDEXED 0570

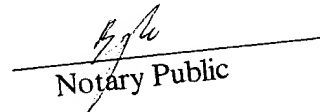
rights, titles, benefits, privileges, and advantages hereby sold, assigned, transferred and conveyed, and that we will sign any applications for reissue which may be desired by the owners of the patent or patents which may be issued for the said invention or improvements.

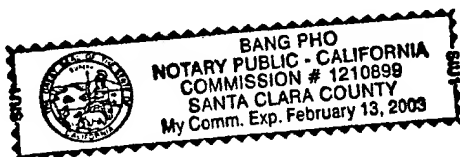
IN WITNESS WHEREOF, WE, the said LEONARD SCOTT VEIL and ERICA ELISABETH TUPS, have hereunto set our hands and seals on the date below written.

  
LEONARD SCOTT VEIL

STATE OF CALIFORNIA )  
 ) ss.  
COUNTY OF SANTA CLARA)

BE IT KNOWN, that on this 11 day of May, 2001, before me personally came LEONARD SCOTT VEIL, to me known and known to me to be the person mentioned in and who executed the foregoing assignment, and he acknowledged to me that he executed the same as his free act and deed for the use and purposes therein mentioned. SUBSCRIBED AND SWORN before me, the undersigned authority, by on this 11 day of May 2001.

  
Notary Public



SEAL

  
ERICA ELISABETH TUPS

STATE OF CALIFORNIA )  
 ) ss.  
COUNTY OF SANTA CLARA)

BE IT KNOWN, that on this 11 day of May, 2001, before me personally came ERICA ELISABETH TUPS, to me known and known to me to be the person mentioned in and who executed the foregoing assignment, and he acknowledged to me that he executed the same as his free act and deed for the use and purposes therein mentioned. SUBSCRIBED AND SWORN before me, the undersigned authority, by on this 11 day of May 2001.

  
Notary Public



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**Patent #:** 6449720    **Issue Dt:** 09/10/2002    **Application #:** 09313295    **Filing Dt:** 05/17/1999

**Inventors:** STEVEN K. SPRAGUE, GREGORY J. KAZMIERCZAK

**Title:** PUBLIC CRYPTOGRAPHIC CONTROL UNIT AND SYSTEM THEREFOR

**Assignment: 1**

**Reel/Frame:** 010258/0189

**Recorded:** 09/21/1999

**Pages:** 3

**Conveyance:** ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

**Assignors:** SPRAGUE, STEVEN K

**Exec Dt:** 05/19/1999

KAZMIERCZAK, GREGORY J.

**Exec Dt:** 09/01/1999

**Assignee:** WAVE SYSTEMS CORP.

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**Correspondent:** ALLAN J. JACOBSON

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**Title:** PUBLIC CRYPTOGRAPHIC CONTROL UNIT AND SYSTEM THEREFOR

**Assignors**

**1** SPRAGUE, STEVEN K

**Exec Dt:** 05/19/1999

**2** KAZMIERCZAK, GREGORY J.

**Exec Dt:** 09/01/1999

**Assignee**

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**Correspondence name and address**

ALLAN J. JACOBSON

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